



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,052	10/12/2001	Benjamin D. Pless	N02-01	1806
26876	7590	08/12/2004	EXAMINER	
NEUROPACE, INC. 1375 SHOREBIRD WAY MOUNTAIN VIEW, CA 94043			LAYNO, CARL HERNANDZ	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,052

Applicant(s)

PLESS ET AL.

Examiner

Carl H. Layno

8/9/04

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64-89 is/are allowed.
- 6) ☒ Claim(s) 2,5,6,18,19,21,29,30 and 57-62 is/are rejected.
- 7) ☒ Claim(s) 3,4,7-17,20,22-28,31-56 and 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgement is made of applicant's amendment, which was received by the Office on April 23, 2004. This document has been made of record in the file as Paper No.11.

2. Claim 1 is canceled. Claims 2-89 remain active and pending.

Application Revived

3. Acknowledgement is made of applicant's petition to revive this application, which had been unintentionally abandoned on February 19, 2004. Applicant's petition, filed under 37 CFR 1.137(b), was received on April 23, 2004 and has been approved and filed in this case as Paper No.10.

Oath/Declaration

4. The Examiner would like to thank the applicant for pointing out the presence of the Application Data Sheet (Paper No.5), which contains the names and mailing/post office addresses of each inventor. In view of this submission, the Examiner is withdrawing the 37 CFR 1.67(a) objection which was made against the declaration in the last Office action.

Claim Rejections - 35 USC § 112

Art Unit: 3762

5. In view of applicant's modifications to claim 64, the Examiner is withdrawing the 35 U.S.C 112 2nd paragraph rejections which were made against claims 64-89 in the last Office action.

Claim Rejections - 35 USC § 102

6. Upon further reconsideration of applicant's cancellation of claim 1 and modifications to claim 2 and other claims, the Examiner is withdrawing the 35 U.S.C 102(b) rejection of Dorfmeister et al '868 which was made against claims 1, 3, 4, 6, and 57 in the last Office action.

7. Applicant's arguments with respect to claim 2 have been considered but are moot in view of the new ground(s) of rejection.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2, 5, 6, 18, 19, 21, 29, 30, and 57-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Snell '999.

Upon further review of the Snell '999 patent, cited previously by the Examiner as relevant prior art, the Examiner discovered that the device system disclosed (Fig.1) did include all of applicant's claimed method steps. Specifically, Snell '999 system discloses an implantable medical device (IMD) 30 (Fig.1) in communication with an external programmer 32. In use,

Art Unit: 3762

parametric and information data is uploaded to the external programmer from the IMD **202** (Fig.7). A Historical Patient Data File (HPDF) template is formed **204,206**. The parameters within this HPDF may then be updated at a remote site, such as at a hospital database **194** (Fig.6), and annotations added by an attending user or medical practitioner **162,164** (Fig.4 -- col.10, lines 35-38). When finished, the HPDF is downloaded back into the memory **38** (Fig.1) of the IMD **30**. See block **238** (Fig.8). If memory is limited in the IMD, a data compression subroutine can be used to shrink its size **224** (Fig.8).

In regard to claim 5, parametric data stored in the HPDF include, but are not limited to, remaining battery life, AV delay, pulse width, pulse energy content, and lead impedance (col.9, lines 57-61).

In regard to claim 6, applicant's attention is directed to col.10, lines 35-38.

In regard to claim 18, tests are conducted after downloading the HPDF. See block **216** (Fig.7) and Fig.4.

In regard to claim 19, one of the tests, which may be conducted, is a capture threshold test (col.13, line 57).

In regard to claim 21, another "pre-processing" test conducted by Snell '999 is a calibration measurement test (col.13, lines 53-54).

In regard to claim 29, tests may be repeated. See col.13, lines 57-60.

In regard to claim 30, test results are saved in the HPDF template (col.13, lines 63-65).

In regards to claims 57 and 58, the implantable device uses a wireless link (i.e. telemetry circuit **46** – Fig.1) to upload the HPDF to the external programmer **32**.

In regards to claim 59-61, applicant's claims read on the scenario where data is first uploaded from the IMD 30 then sent to a hospital network or remote site via a communications link 68 (Fig. 1). This link may be a physical or cellular telephone link – see col.9, lines 4-10.

Allowable Subject Matter

10. Claims 3, 4, 7-17, 20, 22-28, 31-56, and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 64-89 are allowed.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (703) 308-3694. The examiner can normally be reached on Monday thru Thursday from 9 AM to 6 PM and every other Friday between 9AM and 5PM. A voice mail or E-mail message (carl.layno@uspto.gov) may be left if desired.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes, can be reached on (703) 308-5181. All faxed correspondence should be sent to the Office's new Official FAX number (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Legal Instruments Examiner (LIE) Brenda Webb whose telephone number is (703) 305-7520.

Application/Control Number: 09/977,052
Art Unit: 3762

Page 6

Carl H. Layno

CARL LAYNO
PRIMARY EXAMINER

CHL
8/9/2004